UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte YEUK-FAI EDWIN MOK *and* SON T. NGUYEN

Appeal 2007-0841
Application 10/823,849
Technology Center 2818

Decided: May 10, 2007

Before RICHARD E. SCHAFER, RICHARD TORCZON, and CAROL A. SPIEGEL, *Administrative Patent Judges*.

TORCZON, *Administrative Patent Judge*.

DECISION ON APPEAL

INTRODUCTION

The claimed invention generally relates to a system for annealing semiconductor substrates. The Examiner found that a published application[1] anticipated all pending claims under 35 U.S.C. 102(e). The Applicants (Mok) have appealed. We reverse.

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[1] Michael X. Yang et al., "Multi-chemistry plating system", US 2004/0016637 A1 (published 29 January 2004) (Yang).

BACKGROUND

Mok's application was filed 13 April 2004.[2] Mok claims the benefit of a provisional application filed 18 April 2003. The Examiner does not contest Mok's benefit claim.

The Office published the Yang application on 29 January 2004.[3] The Yang application was filed on 8 July 2003 and claims the benefit of numerous applications including a provisional application, 60/435,121, filed 19 December 2002.[4] The Examiner relies on the provisional application to establish an effective filing date for purposes of §102(e).

ANALYSIS

Section 102(e)(1) provides in relevant part that an Applicant is not entitled to a patent if the claimed invention—

> was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent....

As a threshold matter, we must be satisfied that the Yang published application qualifies as prior art under §102(e)(1). The Yang published application does not, on its face, have a sufficiently early filing date to anticipate Mok's claims. The '121 provisional application cannot itself be the basis of the rejection since it was not published as §102(e) requires.[5]

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[2] Application, certificate of mailing.
[3] Yang, coversheet.
[4] Yang, coversheet.
[5] *In re Wertheim*, 646 F.2d 527, 535, 209 USPQ 554, 562 (CCPA 1981) (criticizing the board opinion because "an abandoned [benefit] application by itself can never be a reference").

Thus, the question is whether the Yang application should be given the effective filing date of the '121 provisional application.

According to binding precedent,[6] the purpose of §102(e) is the codification of the Supreme Court's holding in *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390 (1926). The *Wertheim* court explained that a benefit application can only provide an effective filing date for a reference if, "'but for' the delays in the Patent Office, the patent would have earlier issued and would have been prior art known to the public."[7] Any delay in publishing the '121 provisional application can in no way be attributed to the Office, however, since a provisional application is excepted from publication.[8] Similarly, any delay in issuing the '121 provisional application cannot be attributed to the Office since provisional applications do not automatically proceed to examination and thence issuance.[9]

The Examiner has the initial burden in making a rejection to set forth the basis for the rejection. In the present case, the Examiner has not articulated a theory on why the '121 provisional application would have been available as a reference but for the delays of the Office. It appears that the filers of the '121 provisional application chose a route that would ensure that it not become available as a reference without some further action on their part. Thus, even assuming that the '121 provisional application has the

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[6] *Wertheim*, 646 F.2d at 532, 209 USPQ at 559, binding in view of *South Corp. v. United States*, 690 F.2d 1368, 1369-71, 215 USPQ 657, 657-58 (Fed. Cir. 1982) (en banc).
[7] *Wertheim*, 646 F.2d at 536, 209 USPQ at 563.
[8] 35 U.S.C. 122(b)(2)(A)(iii).
[9] 35 U.S.C. 111(b)(5) (provisional applicant must request provisional application be treated as an application or face abandonment).

requisite anticipating disclosure, it does not follow that it provides an effective date for the published application.

The *Wertheim* court complained that the Examiner had done nothing to establish the earlier date other than noting 35 U.S.C. 120.[10] In the present case, the Examiner's answer is silent and the final rejection merely says "See MPEP 706.02(f)(1)[R-3]; for example, see Example 2."[11] Currently (revision 5), Example 2 under §706.02(f)(1) of the Manual of Patent Examining Procedure (MPEP) states—

> For reference publications and patents of patent applications filed under 35 U.S.C. 111(a), the prior art dates under 35 U.S.C. 102(e) accorded to these references are the earliest effective U.S. filing dates. Thus, a publication and patent of a 35 U.S.C. 111(a) application, which claims *>benefit< under 35 U.S.C. 119(e) to a prior U.S. provisional application or claims the benefit under 35 U.S.C. 120 of a prior nonprovisional application, would be accorded the earlier filing date as its prior art date under 35 U.S.C. 102(e), assuming the earlier-filed application has proper support for the subject matter as required by 35 U.S.C. 119(e) or 120.

The only change from revision 3 on which the examiner relied appears to be the substitution of "*>benefit<" for "priority". Note that the MPEP example treats a benefit claim to a provisional application under 35 U.S.C. 119(e) as equivalent to a benefit claim to a prior application under §120. Section 119(e)(1) reinforces this parallelism by using language functionally equivalent to the language of §120.[12] The problem with the Examiner's position is that neither §119(e)(1) nor the MPEP address the but-for

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[10] *Wertheim*, 646 F.2d at 535, 209 USPQ at 562.
[11] Final rejection at 7.
[12] Compare §119(e)(1) with §120.

requirement of extending back reference filing dates under §102(e). Nothing in §119(e)(1) expressly or even implicitly overturns the binding precedent.

It is tempting to say that *Wertheim* was wrong to import a but-for requirement into §102(e) or that subsequent amendments to §102(e) have eviscerated *Wertheim*. The time to make those arguments, however, is when the rejection is made. On the present record, the '121 provisional application does not appear to be available to back-date the Yang published application. The Yang published application is not sufficiently early to anticipate on its own. Consequently, we have no proper prior art for the §102(e) rejection.

REVERSED

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